

### **REMARKS**

Applicants concurrently filed with the present response a Request for a Three-Month Extension of Time under 37 CFR 1.136(a) with an authorization to charge the requisite fee under 37 CFR 1.17(a)(3) to Applicants' representative Deposit Account 13-2725. If for any reason the Request is separated from the present response, then Applicants authorize the Office to charge the above-noted Deposit Account to pay any necessary fees so as to maintain the pendency of the present application.

Claims 1-23 were pending prior to the present amendment. Claims 1, 2, 12 and 17-21 have been cancelled. New claims 24-32 have been added. Claims 24 -27 are independent claims based on original claims 1, 2 in part, 18, 19 and 21 and the specification. The four new independent claims are presented for purposes of clarification.

Claims 1-23 were rejected under 35 U.S.C. §112, 2<sup>nd</sup> para. It is respectfully submitted that the above amendment obviates this rejection.

Thus, for example, clarification has been presented in new claims 24 -27 to resolve the problem with T, T' and T'' with regard to an isocyanate group and an isocyanate reactive group. T and T' are now defined as isocyanate reactive groups and T'' is defined as an isocyanate group. The isocyanate reactive groups are in part taken from original claim 2. In claim 26, T'' is an isocyanate reactive group based on the latter part of original claim 2. Claim 2 has been cancelled. In claim 26, a component (iii) has been introduced as the isocyanate group for clarification.

The definitions of k and k' have been clarified by removing the word "about".

Claims 25 and 27 based on former claim 18 no longer claims a mixture. Claim 17 has been cancelled.

The objection to claim 5 is not understood. Nevertheless for purposes of clarification, the claim has been amended to read as the amount of solvent capable of dissolving between 0.01%

and 5.0% by weight of component the fluorinated polyether isocyanate derived silane. See the specification at page 5, lines 16-18.

The rejection of claims 1-23 under 35 U.S.C. §112, 1<sup>st</sup> para. is also deemed obviated by the present amendment for the same reasons as mentioned above with regard to the prior definitions of T, T' and T''.

The rejection of the claims under obvious type double patenting over application No. 10/729,073 is respectfully traversed. The criterion in double patenting rejections is to make a comparison of the claims. The claims in the '073 patent are distinct from the present claims in at least the presence of additional components not defined herein. In addition claims in the '073 patent do not include the possibility of a surfactant, claims to an article, method of treating glass or ceramic substrates, etc. The two applications are distinct from one another. The rejection should be withdrawn.

The rejection of claims 1, 2 and 5-23 under 35 U.S.C. 102(e) as allegedly anticipated by Moore et al., US 6,649,272 is not warranted in view of new claims 24-27. The '272 patent does not teach the fluorinated polyether isocyanate derived silane as presently defined. Withdrawal of the rejection is earnestly solicited.

The rejection of claims 1, 2 and 5-23 under 35 U.S.C. 102(b) as allegedly anticipated by WO 02/30848 is deemed moot in view of the present amendment for the reasons above with regard to the definition of the isocyanate derived silane in new claims 24-27.

Reconsideration is respectfully requested with regard to the rejection of claims 3 and 4 as allegedly obvious over the '272 patent or WO 02/30848 in view of Brown('624) or Scicchitano et al. (US2002'0016267) or WO 01/34670. The present invention provides novel compositions that address what is not addressed in the prior art and in the primary WO 02 reference, chemical stability, particularly with regard to alkaline treatment. (See page 4, line 18 to page 5, line 2). Moreover, applicants have compared such stability to a composition from WO 02/30848. The Examiner is invited to look at the Table at pages 33 and 34 comparing the compositions of the present invention to comparative example C1, which is example 50 from the WO 02 reference.

In the last column showing data post base treatment, there is a marked difference between 61/38 for C1 and the much higher numbers for compositions 1-9 and 12-15. In view thereof, any alleged *prima facie* obviousness has been rebutted by the comparative testing in applicant's specification. Patentability is not relied on solely for adding a surfactant as can be seen from the specification and the Examples. The Examiner's rejection is thus no longer warranted and should be withdrawn.

In view of the remarks contained herein, Applicants respectfully request a Notice of Allowance. If the Examiner believes that a discussion would advance the prosecution of this application, the Examiner is invited to telephone the undersigned at the below-listed telephone number.

Respectfully submitted,  
MERCHANT & GOULD P.C.  
P.O. Box 2903  
Minneapolis, Minnesota 55402-0903  
(404) 954-5100

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Ronald A. Daignault, Esq.  
Reg. No. 25,968

